



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,289	05/31/2002	Vega Masignani	PP01639.102; 2300-1639	6882

7590 05/20/2008
Chiron Corporation
Intellectual Property Department R440
PO Box 8097
Emeryville, CA 94662-8097

EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
----------	--------------

1645

MAIL DATE	DELIVERY MODE
-----------	---------------

05/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/031,289	Applicant(s) MASIGNANI ET AL.	
	Examiner S. Devi, Ph.D.	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10, 24, 26-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 26-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>040208</u> . | 6) <input type="checkbox"/> Other: ____. |

RESPONSE TO APPLICANTS' AMENDMENT

Applicants' Amendment

- 1)** Acknowledgment is made of Applicants' amendment filed 02/26/08 in response to the non-final Office Action mailed 08/29/07.

Status of Claims

- 2)** Claim 1 has been amended via the amendment filed 02/26/08.
New claims 34-36 have been added via the amendment filed 02/26/08.
Claims 1, 10, 24, 26-28 and 30-36 are pending.
Claims 1, 10, 26-28 and 30-32 are under examination.

Information Disclosure Statement

- 3)** Acknowledgment is made of Applicant's Information Disclosure Statement filed 04/02/08. The information referred to therein has been considered and a signed copy is attached to this Office Action.

Objection to Specification

- 4)** The specification is objected to for the following reason(s):
- (a) The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. See for example line 3 of page 1. Applicants are required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the Applicant(s), or a practitioner representing the Applicants(s), stating that the amendatory material consists of the same material incorporated by reference in the referencing application.

A compliant Sequence Listing in the instant application must include all sequences from WO 99/36544.

Rejection(s) Withdrawn

- 5)** The rejection of claims 1, 10, 26-28 and 30-32 made in paragraph 10 of the Office Action mailed 02/28/07 and maintained in paragraph 9 of the Office Action mailed 08/29/07 under 35 U.S.C. § 112, first paragraph, as containing new matter, is withdrawn in light of Applicants' amendment to the base claim and Applicants' arguments.

Rejection(s) under 35 U.S.C § 112, First Paragraph (Written Description)

- 6) The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 7) Claims 1, 10, 26-28 and 30-32 are rejected under 35 U.S.C § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The instantly recited SEQ ID NO: 1331 is 18 amino acids in length. The claimed purified polypeptide genus that comprises this 18 amino acid-long SEQ ID NO: 18 is 100 amino acids or less in length, or 50, 25 or 20 amino acids in length and that comprises at least one antigenic determinant. The open claim language ‘comprising’ allows the claimed polypeptide to have any amino acids in any number and in any sequence along the length of SEQ ID NO: 1331 including those from non-meningococcal ORF 114-1 protein as long as the length of the polypeptide is 100 amino acids or less. The limitation ‘*N. meningitidis* serogroup B’ encompasses any strain, any serotype, or any immunotype of *N. meningitidis* serogroup B. The limitation ‘antibodies raised’ includes monoclonal and polyclonal antibodies raised against any strain, any serotype, or any immunotype of *N. meningitidis* serogroup B. The at least one antigenic determinant comprised within the polypeptide is not required to be within SEQ ID NO: 1331, but can be an antigenic determinant present outside SEQ ID NO: 1331. The limitation ‘antigenic determinant’ encompasses linear and conformational antigenic determinants or contiguous and discontinuous antigenic determinants. The specification intends at least diagnostic applications for the claimed polypeptide.

The written description requirement can be met by describing the claimed subject matter to a person skilled in the art using sufficiently detailed, relevant identifying characteristics such as functional characteristics, and correlating those functional characteristics with a disclosed structure. See *Enzo Biochem v. Gen-Probe*, 323 F.3d 956, 964, 967, 968 (Fed. Cir. 2002). Sufficient description to show possession of a genus may be achieved by means of disclosure of a

Art Unit: 1645

May 2008

representative number of polypeptides, defined by amino acid sequences falling within the scope of the genus, or recitation of structural features common to members of the genus, which features constitute a substantial portion of the genus. *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. Possession may *not* be shown by merely describing how to obtain possession of members of the claimed genus or how to identify their common structural features. See *University of Rochester*, 358 F.3d at 927, 69 USPQ2d at 1895.

In the instant application, Applicants have shown possession of one peptide species, i.e., the full length SEQ ID NO 1331 that is 18 amino acids in length. The disclosed structure or the amino acid sequence of the peptide species, SEQ ID NO: 1331, is depicted on page 67 which is the amino acids 959-976 of ORF 114-1 disclosed in WO 9936544. The structure of the at least one antigenic determinant comprised within the 18 amino acid-long SEQ ID NO: 1331 or within the claimed 100 amino acid-long, 50 amino acid-long, 25 amino acid-long, or 20 amino acid-long polypeptide comprising SEQ ID NO: 1331 is not correlated with the requisite ability to detect the presence of antibodies raised against homologous or heterologous *N. meningitidis* serogroup B. The antibodies raised against homologous or heterologous *N. meningitidis* serogroup B are expected to be directed to surface-exposed antigenic determinants of a protein of said heterologous or homologous *N. meningitidis* serogroup B, but not to antigenic determinants of said protein that are non-surface-exposed or buried. Antibodies raised against a strain, serotype, subtype, or immunotype of *N. meningitidis* serogroup B are immunospecific to one or more surface-exposed strain-specific, serotype-specific, or immunotype-specific antigenic determinants. However, the accessibility of SEQ ID NO: 1331 or at least one antigenic determinant therein, on the cell surface of any strain, serotype, subtype, or immunotype of *N. meningitidis* serogroup B is neither disclosed within the instant specification, nor is it known in the state of the art. It is well recognized in the art of meningococcal proteins that not all meningococcal proteins and not all parts of a particular meningococcal protein are exposed on the cell surface. See abstract of Gomez *et al. Vaccine* 14: 1340-1346, 1996; and Figure 4 of Malorny *et al. J. Bacteriol.* 180: 1323-1330, 1998. Some epitopes are buried while some are surface exposed. See abstract of Teerlink *et al. J. Exp. Med.* 166: 63-76, 1987 and Forest *et al. Gene* 192: 165-169, 1997. For instance, antibodies raised against the 13,000 Mr peptide CB1 could not be absorbed with intact outer membranes complexes

Art Unit: 1645

May 2008

suggesting that this peptide is buried within outer membranes of the bacteria. See abstract of Teerlink *et al.* Similarly, sera raised against certain epitopes of some meningococcal proteins failed to label whole cells suggesting lack of surface accessibility. See abstract of Ala'Aldeen *et al. Vaccine* 12: 535-541, 1994. The state of the art recognizes that antibodies that react with intact meningococcal bacteria (and thereby detect the meningococcal bacteria) **must** recognize epitopes on the cell surface. See sentence bridging the two columns on page 1327 and page 1323 of Malorny *et al.* In the instant case, whether or not the at least one antigenic determinant of the a8 amino acid-long SEQ ID NO: 1331 is surface-exposed or buried deep within, is neither disclosed, nor is it known in the art. Whether or not the at least one antigenic determinant in SEQ ID NO: 1331 is serotype-specific or strain-specific is not known. There is inadequate written description establishing a structure-function relationship between the 18 amino acid-long SEQ ID NO: 1331 or an 100, 50, 25 or 20 amino acid-long, or less than 100 amino acid-long polypeptide comprising SEQ ID NO: 1331, or at least one antigenic determinant therein, and its ability to detect the presence of antibodies raised against homologous or heterologous strain, serotype, subtype, or immunotype of *Neisseria meningitidis* serogroup B. Note that *Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 1111, clearly states: 'Applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed'. See page 1117. It should be noted that written description requires more than a mere statement that something is a part of the invention. Applicants have not described what contiguous or discontinuous antigenic determinants, or conformational or non-conformational epitopes of the claimed polypeptide comprising SEQ ID NO: 1331 are correlated with the required capacity to detect the presence of antibodies raised against any *Neisseria meningitidis* serogroup B. Applicants should note that written description requires more than a mere statement that something is part of the invention and a reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

With respect to the written description requirement, while 'examples explicitly covering the full scope of the claim language' typically will not be required, a sufficient number of

Art Unit: 1645

May 2008

representative species must be included ‘to demonstrate that the patentee possesses the full scope of the [claimed] invention’. *Lizardtech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1732 (Fed. Cir. 2005). In the instant case, Applicants’ specification does not contain a written description sufficient to show they had possession of the full scope of the claimed invention at the time the application was filed. The instant specification mentions of a peptide of SEQ ID NO: 1331 on page 67. However, the specification does not disclose a correlation between function (i.e., capacity to detect the presence of antibodies raised against *Neisseria meningitidis* serogroup B) and structure of at least one antigenic determinant responsible for that function, for one of skill in the art to practice the invention. Clearly, Applicants did not describe the invention of the instant claims sufficiently to show that they had possession of the claimed genus of polypeptides. See e.g., *Noelle v. Lederman*, 355 F.3d 1343, 1348, 69 USPQ2d 1508, 1513 (Fed. Cir. 2004) (‘invention is, for purposes of the written description inquiry, *whatever is now claimed*’).

As known in the art of immunology, an epitope or antigenic determinant can be linear, or conformational or discontinuous, and it specifically interacts with its corresponding antibody based on the three dimensional structure of both the molecules and the fit between the molecules. See page 46 of Cruse *et al.*, *Illustrated Dictionary of Immunology*, 2nd Edn., CRC Press, 2003. The specification does not adequately describe or identify the linear or conformational *Neisseria meningitidis* serogroup B epitopes, serotype-specific, non-serotype-specific, or strain-specific, within the 18 amino acid-long SEQ ID NO: 1331 or within the at least 100 amino acid-long polypeptides comprising SEQ ID NO: 1331. Discontiguous epitopes are formed from different regions of the primary sequence brought together by proper protein folding. Antibodies binding to conformational epitopes bind only to proteins folded into their proper native form. See page 166 of Cruse *et al.* *Illustrated Dictionary of Immunology*, 2nd Edn., CRC Press, 2003. Linear epitopes are generally not found on the surface of a folded polypeptide and are available to antibodies only upon denaturation of a polypeptide. See page 382 of Cruse *et al.* Since the instant invention contemplates diagnostic applications for the claimed polypeptide, the claimed product has to detect raised antibodies having binding specificity to the properly folded polypeptide of SEQ ID NO: 1331 as found on the surface of any *Neisseria meningitidis* serogroup B. The structure of at least

Art Unit: 1645

May 2008

one antigenic determinant within the 18 amino acid-long SEQ ID NO: 1331 capable of detecting the presence of antibodies raised against any *Neisseria meningitidis* serogroup B is not described. With specific regard to meningococcal proteins, it is known in the art that even the amino acid residues outside an antigenic determinant but in the vicinity of an antigenic determinant are critical to the immunospecific binding to antibodies. For instance, McGuinness *et al.* (*Mol. Microbiol.* 7: 505-514, Feb 1993) taught that “[a] single amino acid change within an epitope, or an amino acid deletion outside an epitope, were both associated with loss of subtype specificity resulting from a change in the predicted conformation at the apex of the loop structure” in case of a meningococcal polypeptide (see abstract). In the instant application, in addition to the lack of adequate description of the at least one antigenic determinant that within the claimed polypeptide that has the capacity to detect antibodies raised against *Neisseria meningitidis* serogroup B, the precise amino acids outside the at least one antigenic determinant of the claimed polypeptide that may potentially influence the conformation and the antibody-detecting ability, is not described. Without a correlation between structure and function, the claims do little more than define the claimed invention by function. That is not sufficient to satisfy the written description requirement. *Ex parte Kubin*, 83 USPQ2d 1410 (Bd. Pat. Appl. & Int. 2007) citing *Eli Lilly*, 119 F.3d at 1568, 43 USPQ at 1406 (‘definition by function does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is’). The instant claims are viewed as not meeting the written description provision of 35 U.S.C. § 112, first paragraph.

Remarks

- 8) Claims 1, 10, 26-28 and 30-32 stand rejected.
- 9) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. The Fax number for submission of amendments, responses and/or papers is (571) 273-8300, which receives transmissions 24 hours a day and 7 days a week.
- 10) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAG or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

Art Unit: 1645

May 2008

direct.uspto.Mov. Should you have questions on access to the Private PAA system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

11) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Shanon Foley, can be reached on (571) 272-0898.

/S. Devi/
S. Devi, Ph.D.
Primary Examiner
AU 1645

May, 2008